

Remarks

This is responsive to the Office Action mailed August 7, 2009. The amendments and accompanying remarks herein are proper, do not introduce new matter, and are entirely tangentially related to patentability, thereby not made for reason of patentability in response to a rejection over a cited reference.

The amendments to the drawings and specification correct typographical errors; Applicant regrets any confusion these errors may have caused.

Claim 1 and the claims depending therefrom are amended without prejudice to more particularly define the liner structure in terms of the disclosed embodiments having a longitudinal wall portion 264 and a radially inward extending bottom 266 extending from the wall portion.

Interview Summary Mailed September 30, 2009

The Interview Summary mailed 9/30/2009 makes mention of but does not provide a copy of an amendment suggested by the Office to obviate the standing rejections.

Applicant respectfully requests that the Office supplement the Interview Summary with a copy of its suggested amendment in accordance with the intended procedure that all business of the Office be performed in writing.¹

Rejection under Section 112(2) of Claims 1, 3-14, and 21-22

Claims 1, 3-14, and 21-22 stand rejected as allegedly being indefinite under 35 U.S.C. § 112, second paragraph.

The Office rejected claim 1 because “there is no antecedent basis for ‘the surface’ of the second end of the liner.”² Applicant has canceled the disputed language to obviate the rejection.

The Office rejected claim 7 because “there is no antecedent basis for ‘the bottom of the liner.’”³ Applicant has canceled the disputed language to obviate the rejection.

Applicant respectfully requests the withdrawal of the rejection of claims 1 and 7 and all claims depending therefrom in view of the present clarifying amendments.

¹ 37 CFR 1.2.

² Office Action, pg. 2.

³ Office Action, pg. 2.

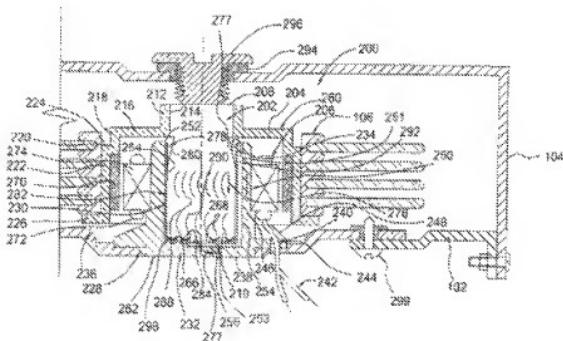
Rejection under Section 102(b) of Claims 1 and 3

Claims 1 and 3 stand rejected under Section 102(b) as allegedly being anticipated by Nii (U.S. Pat. No. 4,938,611).

Claim 1

Claim 1 as previously presented recited *a liner . . . wherein the liner includes . . . a second end . . . wherein the second end includes an inner surface having a hole formed therethrough*. Support for the claimed subject matter includes at least the embodiments of FIG. 2 and the descriptions thereof which disclose the liner 234 having the hole 268 formed in the bottom 266:

FIG. 2



The Office's interpretation is that Nii discloses a fluid dynamic bearing (a) between a liner (6) and a shaft (1);

FIG. 3

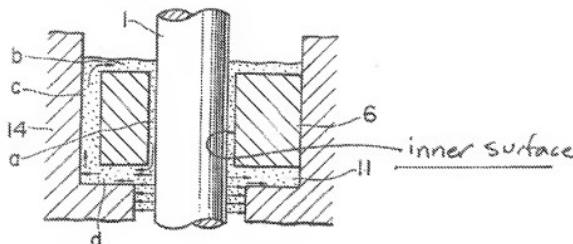


FIG. 3 of Nii is marked up above to denote the "inner surface" of the liner in accordance with the Office's interpretation, because claim 1 features in pertinent part *the shaft configured to rotate on the surface of the second end of the liner*.... However, claim 1 as previously presented also featured *an inner surface having a hole formed therethrough*.... The skilled artisan readily recognizes that Nii's "inner surface" does not have *a hole formed therethrough* as featured by previously presented claim 1; Nii's "inner surface" defines a hole but does not have a hole formed through it. That feature remains in the more particular language of amended claim 1 in terms of *the liner having...a bottom extending radially inward from the wall, the bottom having a hole formed therethrough*....

Applicant was entitled to a complete action on the merits: "the examination shall be complete with respect...to the patentability of the invention as claimed...."⁴ As shown above, the Office's examination is incomplete for failing to consider all of the claimed features, particularly for not substantiating evidence that Nii discloses at least *an inner surface having a hole formed therethrough*. As such, the final rejection is premature for being the result of an incomplete examination, and Applicant therefore respectfully requests reconsideration and withdrawal of the final rejection.

Notwithstanding the lack of a *prima facie* showing of anticipation, Applicant has nonetheless amended the claims without prejudice to remove the issue and facilitate progress on the merits. Claim 1, as amended, more particularly features the liner in terms of having a longitudinal wall and a bottom extending radially inward from the wall, the bottom having a hole formed therethrough. Applicant respectfully requests reconsideration

⁴ 37CFR 1.104(a)(1) (emphasis added).

and withdrawal of the rejection of claim 1 and the claims depending therefrom in view of the clarifying amendments. Absent the requested reconsideration, the fact that the Office has not substantiated evidence that Nii identically discloses all the features of claim 1 leaves an unresolved issue that must be addressed before it can be said that this case is in condition for appeal.

Claim 3

Claim 3 stands rejected on the basis of the same rationale as claim 1.⁵ For the reasons stated above, Nii neither discloses *an inner surface having a hole formed therethrough*.... as featured by previously presented claim 1 from which claim 3 depends, nor does Nii disclose *the recirculation channel extending along the wall and along the bottom* as featured by amended claim 3. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 3.

Rejection under Section 103(a) of Claims 1, 3, 6, 9-14, and 21-22

Claims 1, 3, 6, 9-14, and 21-22 stand rejected as allegedly being unpatentable over Usui (U.S. Pat. No. 5,924,798) in light of Nii.

Claim 1

As discussed above for the Section 102 rejection over Nii, claim 1 recites *a liner . . . wherein the liner includes . . . a second end . . . wherein the second end includes an inner surface having a hole formed therethrough*. The Office's interpretation is that Usui discloses a liner (5b):

⁵ Office Action, pgs. 2-3.

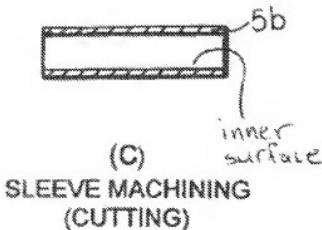


FIG. 3(c) of Usui is marked up above to denote the “inner surface” of the liner in accordance with the Office’s interpretation, because claim 1 as previously presented also featured in pertinent part *the shaft configured to rotate on the surface of the second end of the liner....* However, claim 1 as previously presented also featured *an inner surface having a hole formed therethrough....* The skilled artisan readily recognizes that Usui’s “inner surface” does not have *a hole formed therethrough* as featured by claim 1; Usui’s “inner surface” defines a hole but does not have a hole formed through it. That feature remains in the more particular language of amended claim 1 in terms of *the liner having...a bottom extending radially inward from the wall, the bottom having a hole formed therethrough....*

Again, Applicant was entitled to a complete action on the merits: “the examination shall be complete with respect...to the patentability of the invention as claimed....”⁶ As shown above, the Office’s examination is incomplete for failing to consider all of the claimed features, particularly for not substantiating evidence that Usui discloses at least *an inner surface having a hole formed therethrough*. As such, the final rejection is premature for being the result of an incomplete examination, and Applicant therefore respectfully requests reconsideration and withdrawal of the final rejection.

Notwithstanding the lack of a *prima facie* showing of obviousness, Applicant has nonetheless amended the claims without prejudice as discussed above to remove the issue and facilitate progress on the merits. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom in view of the clarifying amendments. Absent the requested reconsideration, the fact that the Office has

⁶ 37CFR 1.104(a)(1) (emphasis added).

not substantiated evidence that Usui teaches all the features of claim 1 leaves an unresolved issue that must be addressed before it can be said that this case is in condition for appeal.

Claim 3

Claim 3 stands rejected on the basis of the same rationale as claim 1.⁷ Usui fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claim 3 depends. As such, the Office has failed to substantiate obviousness by not showing that the cited references, alone or together, teach all the features of claim 3. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 3.

Claim 6

Claim 6 stands rejected on the basis of the same rationale as claim 1.⁸ Usui fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claim 6 depends. As such, the Office has failed to substantiate obviousness by not showing that the cited references, alone or together, teach all the features of claim 6. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 6.

Claims 9 and 10

Claims 9 and 10 stand rejected on the basis of the same rationale as claim 1.⁹ Usui fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claims 9 and 10 depend. As such, the Office has failed to substantiate *prima facie* obviousness by not showing that the cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 9 and 10.

⁷ Office Action, pg. 5.

⁸ Office Action, pg. 5.

⁹ Office Action, pg. 6.

Claim 11

Claim 11 stands rejected on the basis of the same rationale as claim 1.¹⁰ Usui fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claim 11 depends. As such, the Office has failed to substantiate *prima facie* obviousness by not showing that the cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 11.

Claim 12

Claim 12 stands rejected on the basis of the same rationale as claim 1.¹¹ Usui fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claim 12 depends. As such, the Office has failed to substantiate *prima facie* obviousness by not showing that the cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 12.

Claim 13

Claim 13 stands rejected on the basis of the same rationale as claim 1.¹² Usui fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claim 13 depends. As such, the Office has failed to substantiate *prima facie* obviousness by not showing that the cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 13.

Claim 14

Claim 14 stands rejected on the basis of the same rationale as claim 1.¹³ Usui fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed*

¹⁰ Office Action, pg. 6.

¹¹ Office Action, pg. 6.

¹² Office Action, pg. 6.

¹³ Office Action, pg. 7.

therethrough as featured by previously presented claim 1 from which claim 14 depends. As such, the Office has failed to substantiate prima facie obviousness by not showing that the cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 14.

Claims 21 and 22

Claims 21 and 22 stand rejected on the basis of the same rationale as claim 1.¹⁴ Usui fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claims 21 and 22 depend. As such, the Office has failed to substantiate prima facie obviousness by not showing that the cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 21 and 22.

Rejection under Section 103(a) of Claims 1, 3, and 6-8

Claims 1, 3, and 6-8 stand rejected as allegedly being unpatentable over Tanaka (U.S Pub. No. 2001/0022869) in light of Nii.

Claim 1

As discussed above, claim 1 as previously presented recited *a liner . . . wherein the liner includes . . . a second end . . . wherein the second end includes an inner surface having a hole formed therethrough*. The Office's interpretation is that Tanaka discloses a liner (12):

¹⁴ Office Action, pg. 8.

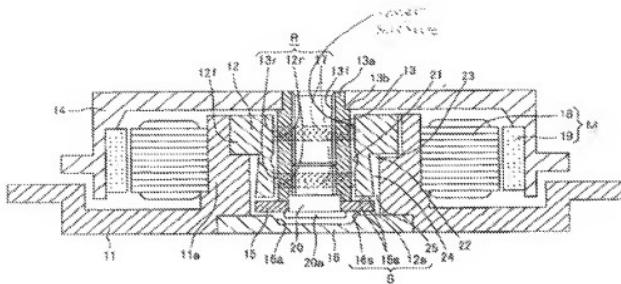


FIG. 1 of Tanaka is marked up above to denote the inner surface of the liner in accordance with the Office's interpretation, because claim 1 as previously presented also featured in pertinent part *the shaft configured to rotate on the surface of the second end of the liner....* However, claim 1 as previously presented also featured *an inner surface having a hole formed therethrough....* The skilled artisan readily recognizes that Tanaka's "inner surface" does not have *a hole formed therethrough* as featured by previously presented claim 1; Tanaka's "inner surface" defines a hole but does not have a hole formed through it. That feature remains in the more particular language of amended claim 1 in terms of *the liner having...a bottom extending radially inward from the wall, the bottom having a hole formed therethrough....*

Again, Applicant was entitled to a complete action on the merits: "the examination shall be complete with respect...to the patentability of the invention as claimed..."¹⁵ As shown above, the Office's examination is incomplete for failing to consider all of the claimed features, particularly for not substantiating evidence that Usui discloses at least *an inner surface having a hole formed therethrough*. As such, the final rejection is premature for being the result of an incomplete examination, and Applicant therefore respectfully requests reconsideration and withdrawal of the final rejection.

Notwithstanding the lack of a *prima facie* showing of obviousness, Applicant has nonetheless amended the claims without prejudice as discussed above to remove the issue

¹⁵ 37CFR 1.104(a)(1) (emphasis added).

and facilitate progress on the merits. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom in view of the clarifying amendments. Absent the requested reconsideration, the fact that the Office has not substantiated evidence that Tanaka teaches all the features of claim 1 leaves an unresolved issue that must be addressed before it can be said that this case is in condition for appeal.

Claim 3

Claim 3 stands rejected on the basis of the same rationale as claim 1.¹⁶ Tanaka fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claim 3 depends. As such, the Office has failed to substantiate prima facie obviousness by not showing that the cited references teach all the features of the rejected claim. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 3.

Claim 6

Claim 6 stands rejected on the basis of the same rationale as claim 1.¹⁷ Tanaka fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claim 6 depends. As such, the Office has failed to substantiate prima facie obviousness by not showing that the cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 6.

Claim 7

Claim 7 stands rejected on the basis of the same rationale as claim 1.¹⁸ Tanaka fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claim 7 depends. As such, the Office has failed to substantiate prima facie obviousness by not showing that the

¹⁶ Office Action, pg. 9.

¹⁷ Office Action, pg. 9.

¹⁸ Office Action, pg. 10.

cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 7.

Claim 8

Claim 8 stands rejected on the basis of the same rationale as claim 1.¹⁹ Tanaka fails to cure the deficiency of Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claim 8 depends. As such, the Office has failed to substantiate prima facie obviousness by not showing that the cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 8.

Rejection under Section 103(a) of Claims 4 and 5

Claims 4 and 5 stand rejected as allegedly being unpatentable over Tanaka in light of Nii as applied to claims 1 and 3, and in further view of Titcomb (U.S. Pat. No. 5,516,212). Titcomb fails to cure the deficiency of Tanaka and Nii regarding at least *an inner surface having a hole formed therethrough* as featured by previously presented claim 1 from which claims 4 and 5 depend. As such, the Office has failed to substantiate prima facie obviousness by not showing that the cited references teach all the features of the rejected claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 4 and 5.

Conclusion

This is a complete response to the Office Action mailed August 7, 2009. Applicant respectfully requests passage of all claims to issuance.

Applicant has also submitted herewith a request for telephone interview if, after having reviewed this Response, the Office determines that any of the claims are not in condition for allowance. The presently requested interview is necessary and appropriate to best facilitate progress on the merits and to resolve, if necessary, the unresolved issues identified herein making this case not in condition for appeal.

¹⁹ Office Action, pg. 10.

The Office is encouraged to contact the undersigned should any question arise concerning this response or anything else concerning this case.

Respectfully submitted,

By: Mitchell K. McCarthy/
Mitchell K. McCarthy, Registration No. 38,794
McCarthy Law Group
512 Northwest 12th Street
Oklahoma City, Oklahoma 73103
1.877.654.6652 or 405.639.3082
www.mccarthyiplaw.com